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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/394,143	09/10/1999	PAUL CHARLES TURGEON	044624-15-NP	3795

24964   7590   03/13/2002

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EXAMINER
HEWITT II, CALVIN L

ART UNIT	PAPER NUMBER
2161	

DATE MAILED: 03/13/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 07-01)

Office Action Summary	Application No.	Applicant(s)
	09/394,143	TURGEON, PAUL CHARLES
	Examiner	Art Unit
	Calvin L Hewitt II	2161

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>6</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>19 December 2001</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☐ Claim(s) _____ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-28</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

    If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some *   c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____ .

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

    a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>11</u>.
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

Status of Claims

1.   Claims 1-26 have been examined

Response to Arguments

2.   .   Applicant is of the opinion that the Examiner's rejection to claims 1-9, 12-20 and 23-26 defective. The Examiner respectfully disagrees. Schrader et al. teach the delivery of finance application stored on portable memory (column 12, lines 62-67) that contains unencrypted data such as a GUI (column 13, lines 13-23) and an encryption module for exchanging transaction instructions with a financial institution (column 14, lines 39-42). Schrader et al. also teach a financial institution that decrypts and authenticates user account data (column 17, lines 12-31). Dolphin teaches unencrypted (evidenced by the users ability to access the data without a special code- e.g. menus) and encrypted (i.e. publisher data that needs to be accessed with a special code) data stored on a portable medium (e.g. CD ROM) (column 4, lines 10-55). Therefore, to one of ordinary skill, the prior art combination teaches a computer-readable storage medium having encrypted and unencrypted information pertaining to a customer account where access to a customer's account is determined from the decrypted information.

Similarly the Applicant has issue with the rejection applied to claims 10, 11, 21, 22, 27 and 28. Recall Schrader et al. teach a financial application stored on portable memory that contains unencrypted data such as a GUI (column 13, lines 13-23) and an encryption module for exchanging transaction instructions with a financial institution (column 14, lines 39-42). Motoyama teaches providing a financial application to a user that contains all the functions of a conventional paper bankbook (column 6, lines 35-47). Bankbook data is private and needs to be securely maintained. Therefore, it would have been obvious to secure this data using the encryption methods of Schrader et al. (column 17, lines 6-40).

Regarding a specific motivation to combine coming explicitly from the prior art...

> A reference is to be considered not for what it expressly states, but for what it would be reasonably have suggested to one of ordinary skill of the art. (*In re Delisle*, 160USPQ 806 (CCPA 1969)).

In addition, the Applicant's failure to challenge the Examiner's assertion that the following is well known has resulted in the fact being acknowledged as admitted prior art:

- update his/her data with regards to changes in name, martial or living status (paper No. 8, page 5 lines 13-15)

The Examiner maintains the rejection to claims 1-28.

Claim Rejections - 35 USC § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for

all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set
forth in section 102 of this title, if the differences between the subject matter sought to be patented and
the prior art are such that the subject matter as a whole would have been obvious at the time the
invention was made to a person having ordinary skill in the art to which said subject matter pertains.
Patentability shall not be negatived by the manner in which the invention was made.

4.   Claims 1-9, 12-20, 23-26 rejected under 35 U.S.C. 103(a) as being

unpatentable over Schrader et al., U. S. Patent No. 5,903,881 in view of Dolphin,

U. S. Patent No. 5,457,746

As per claims 1-6, 9, 12, 17-20, 23 and 26, Schrader et al. teach an online

banking system comprising:

- a personal computer with a browser (figures 3-7; column/line 5/65-6/12;

  column/line 7/58-8/10; column 12, lines 28-67; column 13, lines 45-60)

- private and public networks (figure 13; column 11, lines 40-55; column 12,

  lines 35-52)

- computer readable storage medium (figures 1 and 2; column 2, lines 38-

  52; column 12, lines 53-67; column 13, lines 8-60)

- remote and local encryption/decryption processing (column 14, lines 38-

  43; column 17, lines 11-40)

- remote computer that provides online goods and services and responds to user request for user account data (figures 3-7 and 13; column 11, lines 40-55; column/line 13/814/57)

- displaying unencrypted data to a user including a request for user login identification data (figure 15; column 15, lines 5-55; column/line 16/63-17/5)

- sending user identifier and encrypted information to a remote processor (figure 15; column 15, lines 5-55; column/line 16/63-17/45)

- authentication including extracting user account history (e.g. second identifier such as account number) processor (figure 15; column 15, lines 5-55; column/line 16/6317/45; column/line 18/58-19/24)

- displaying and identifying a users financial institution (figures 2-7; column 11, lines 40-55).

Regarding a "network switch", it is at least obvious that a switch or router is present in order to correctly transmit a users request for account data to the appropriate financial institution (figures 7 and 13; column 11, lines 40-55; column/line 16/63-17/5). Schrader et al. teach a financial computer application that can be delivered to a user on a CD ROM. The application is comprised of executable code and data files (such as transaction instructions, uncleared

transactions, payee information, account information and registration data

(column 12, lines 53-67)). However, Schrader et al. do not teach of

encrypted data stored on a CDROM. Dolphin, on the other hand, teaches a

CDROM whose contents are encrypted (figures 2 and 13; column 4, lines 10-23).

Therefore, it would have been obvious to combine the teachings of Schrader et

al. and Dolphin. Schrader et al. teach an application that provides users with

security using authentication and encryption key protocols (column 17, lines 5-

22). By incorporating the teaching of Dolphin a distributor can encrypt sensitive

data (e.g. uncleared transactions or account information) while leaving non-

sensitive data (e.g. an electronic registration form) unencrypted when the

application is executed on the user's system via a portable storage medium such

as a CDROM.

As per claims 7, 8 and 25 Schrader et al. teach user authentication (figure

15; column 15, lines 28-44; column/line 16/63-17/45) and error handling modules

(column 14, lines 20-27). Therefore, it would have been obvious to one of

ordinary skill in the art of network administration to create a message to inform a

user that his/her request was approved or not approved. Further, it would have

been obvious to request the user to update his/her data with regards to changes

in name, martial or living status. This is a prudent and well-known policy. In order

to communicate with users, particularly "offline" communications, a financial or

academic institution needs to maintain up-to-date contact information.

As per claims 13-16, and 24, Schrader et al. teach CD-ROMs, encryption and authentication in an online banking environment (figure 15; column 12, lines 53-67, column 14, lines 38-43; column 15, lines 5-55; column/line 16/63-17/45; column/line 18/58-19/24). Banks are associated with card producing facilities and files as they issue bank, credit and smart cards. Therefore, it would have been obvious to produce a CD-ROM using whatever means or methodology that would provide the most savings to a business or institution.

5.   Claims 10 and 11, 21,22, 27, 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schrader et al., U. S. Patent No. 5,903,881 in view of Motoyama, U. S. Patent No. 5,913,202 and Polcyn, U.S. Patent No. 6,195,357.

As per claims 10 and 11, Schrader et al. teach displaying financial institution data to a user (figures 1-7; column 11, lines 40-55). However, Schrader et al. do not teach advertisements or voice messages. Motoyama teaches an online banking system that advertises financial products and provides account consultation to a user (column 3, lines 33-67; column 4, lines 1-22; column 5, lines 53-65) while Polcyn applies voice messaging over the internet to financial services (abstract; figures 1 and 2; column 6, lines 4-67). Therefore, it would have been obvious to combine the teachings of Schrader et al., Polcyn and Motoyama. By marketing their products and services a financial institution can retain current and attract new users. A simple but well-known marketing

method is the "greeting". A fear associated with automation is the loss or lack of

human interaction. By sending a user an audio greeting each time he or she

accesses the service injects a little bit of humanity into the system. Further, an

institution can advertise its new products in this same (e.g. audio) manner as

users have been known to ignore online visual ads such as "banners".

Conclusion

6.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of

time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire

THREE MONTHS from the mailing date of this action. In the event a first reply is

filed within TWO MONTHS of the mailing date of this final action and the advisory

action is not mailed until after the end of the THREE-MONTH shortened statutory

period, then the shortened statutory period will expire on the date the advisory

action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be

calculated from the mailing date of the advisory action. In no event, however, will

the statutory period for reply expire later than SIX MONTHS from the mailing

date of this final action.

7.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure:

     •   Lawlor et al. teach remote retail banking services

8.   Any inquiry concerning this communication or earlier communications from

the Examiner should be directed to Calvin Loyd Hewitt II whose telephone

number is (703) 308-8057. The Examiner can normally be reached on Monday-

Friday from 8:30 AM-5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the

Examiner's supervisor, James P. Trammell, can be reached at (703) 305-9768.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

c/o Technology Center 2100

Washington, D.C. 20231

or faxed to:

(703) 746-7239 (for formal communications intended for entry),

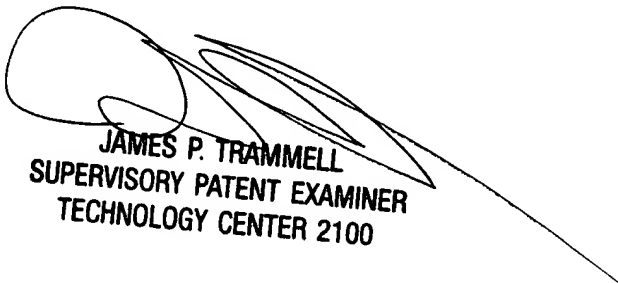(703) 746-7238 (for after-final communications),

or:

(703) 746-7240 (for informal or draft communications, please label

"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,

Arlington, VA, Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application

should be directed to the Group receptionist whose telephone number is (703)

305-3900.

Calvin Loyd Hewitt II

March 11, 2002

JAMES P. TRAMMELL
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100